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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/125,711 | 03/04/1999 | THOMER SHALIT | 097037 | 8095 |
| 22903 | 7590 | 05/19/2004 | EXAMINER | |
| COOLEY GODWARD LLP ATTN: PATENT GROUP 11951 FREEDOM DRIVE, SUITE 1700 ONE FREEDOM SQUARE- RESTON TOWN CENTER RESTON, VA 20190-5061 | | | DINH, DUC Q | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2674 | 53 |

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/125,711

Applicant(s)

SHALIT, THOMER

Examiner

DUC Q DINH

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-20,22-33 and 35-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-20,22-33 and 35-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17-42 and 54 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 17, 30 cite the limitations “a tracking element disposed within said housing, said tracking element configured to track a motion of said housing in a first direction and a second direction different from the first direction”. Although the specification does mention “a tracking device (see page 1, lines 12-13, page 6, lines 6-9 and 24-31). There is no support for the limitation “a tracking element disposed within said housing, said tracking element configured to track a motion of said housing in a first direction and a second direction different from the first direction”.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “tracking element configured to track a motion of said housing in a first direction and a second direction different from the first direction” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Salcudean et al. (U. S. Patent No. 5,790,108).

In reference to claims 17 and 30, Salcudean discloses in Fig. 6-8 an apparatus comprising: a housing 20 with an upper and lower portion having a detector (see 66 in Fig. 1) corresponding to the tracking element; coil 124 and magnet 126 corresponding to the movement

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generator; and spring 128 and 130 corresponding to the resilient material coupled to the housing configured to deliver the tactile sensation as claimed.

In reference to claim 18-19, refer to Fig. 10-11 and column 9, lines 4-63.

In reference to claim 20, Fig. 3 shown movement generator generate the tactile sensation in the arrow directions to generate the tactile sensation over the entirely housing as claimed.

In reference to claim 22, Fig. 7 show the force is applied in the upper portion of the housing as claimed.

In reference to claims 23 and 37, Fig. 7 show the location of the two springs in between the two portion of the housing as claimed.

In reference to claims 24, 38, and 41, 46, Fig. 3-7 shows the movement generator including electromagnetic actuator as claimed.

In reference to claim 25-29 and 31-33 and 39-40, see Fig. 11-12 and associate text in col. 9, lines 4-63.

With reference to claims 35, 42, 49-51 and 54, Salcudean discloses a pair of springs 128 and 130 tend to hold the tactile element in its lower most position as illustrated i.e. closest to the core 122, however when the coil is activated the repulsion of the magnet 126 from the core 122 and the coil 124 is stronger than the tension in the springs 128 and 130 so that the tactile element moves upwardly away from the core 122 with the amount of movement being dependent on the current in the coil 124 (col. 7, lines 30-36).

In reference to claim 43, Fig. 3 shows the movement of the upward force 84 applied to the upper portion of the housing portion with respect to the bottom as claimed.

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In reference to claims 44-45, 47-48 and 53, refer to the rejection as applied to claims 18-19.

Response to Arguments

5. Applicant's arguments with respect to claims 17-20, 22-33, 35-54 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DUC Q DINH** whose telephone number is **(703) 306-5412**. The examiner can normally be reached on Mon-Fri from 8:00.AM-4:00.PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **RICHARD A HJERPE** can be reached on **(703) 305-4709**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9306 (for Technology Center 2600 only)

Hand-delivery response should be brought to: Crystal Park II, 2121 Crystal Drive,
Arlington, Va Sixth Floor (Receptionist)

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 305-4700.

DUC Q DINH
Examiner
Art Unit 2674


REGINA LIANG
PRIMARY EXAMINER

DQD
May 13, 2004